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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,719	04/14/2004	Takao Uehara	S-2490/CONT/CIP	5346
35777	7590	04/06/2006	EXAMINER	
SHERMAN & ASSOCIATES 415 NORTH ALFRED STREET ALEXANDRIA, VA 22314				WU, IVES J
		ART UNIT		PAPER NUMBER
		1713		

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/823,719	UEHARA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ives Wu	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 April 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/14/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(1). **Claims 1 and 3-4** are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamura et al (US005576406A).

Yamamura et al disclose method where the copolymer obtained from monomers comprising alkyl (meth)acrylate and reactive monomer having a group derived from isocyanate group is added to solvent borne paint (Col. 1, line 17-20, Col. 2, line 1-5, 32-36, Col. 3, line 7-8, 32, Col. 17, line 38, and Col. 26, line 59-62). Illustrated in Example 13 which discloses a copolymer obtained from 57.5% (115/200) alkyl (meth)acrylate – 10 parts of MMA, 40 parts of BMA, 19 parts of BA, 46 parts of n-butoxymethyl methacrylate, and 32.5% (65/200) - 65 parts of a methacrylic acid ester monomer possessing the following structure:



(Col. 22)

which is 2-(O-[1-methyl-propylideneamino]carboxyamino)ethyl methacrylate as presently claimed.

As to the defoamer for baking finish type top coat paint for motor vehicle in independent claim 1, the disclosure of Yamamura et al meets the requirements of instant claims both in terms of materials added and their contents. It is reasonable to presume that the composition of Yamamura et al would fulfill the same utility function of defoamer for baking finish type top coat paint for motor vehicle as presently claimed in light of its chemical similarities. The burden is shifted to applicants to establish that the product of the presently claims is not the same as or obvious as that set forth by the reference Yamamura et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

(2). **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamura et al (US005576406A) in view of Simms (US004219632).

As to the component A of a polymerizable monomer having isocyanate groups being able to react with a binder resin in thermosetting paint in **dependent claim 2**, Yamamura et al do not teach this monomer as presently claimed.

However, Simms teaches the low molecular weight isocyanato-acrylate copolymers (Title) such as isocyanatoethyl methacrylate in Examples (Col. 3-4).

The advantage of using presently claimed isocyanate group containing monomer in the copolymers is (1) colorless liquids or solids soluble in organic solvents having molecular weights and viscosities suitable for use in coating applications, (2) also can be used as moisture-curing film former (Col. 2, line 53-62).

Therefore, it would have been obvious at time the invention was made to include the isocyanate group containing monomer of Simms in the composition of Yamamura et al in order to obtain the above-mentioned advantage.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ives Wu whose telephone number is 571-272-4245. The examiner can normally be reached on 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Ives Wu  
Art Unit: 1713  
Date: March 30, 2006

*DW*  
DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700